

## **REMARKS/ARGUMENTS**

Applicant responds herein to the Office Action dated November 27, 2007.

Claims 1-17 are pending in the instant application. Claim 8 has been withdrawn from consideration pursuant to Examiner's Restriction Requirement, and Applicant's election.

### **Amendments to the Claims**

As amended above, claim 1 recites "one or more aberration correction optical elements which are fixed within a path of said light between said light source and said objective lens" (Underline per 37 C.F.R. § 1.121). Similarly, claim 12 is amended to recite "fixing the optical element or elements within said light path of said optical system." (Underline per 37 C.F.R. § 1.121)

Claim 1 and 12 are also amended to delete the phrase "factors such as". Additionally, claims 6 and 14 delete the phrase "unpowered" as it modified "aberration correction optical elements". No new matter has been added by these amendments

### **Rejection under 35 U.S.C. § 112**

Claims 1, 6, 12 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Specifically, claims 1 and 12 are rejected as indefinite for use of the phrase "such as". As amended above, the clause including these words is deleted from the rejected claims.

Claims 6 and 14 are rejected for lack of antecedent basis in the term "unpowered aberration correction optical elements". As amended above, the term "unpowered" has been deleted from these claims. The term "aberration correction optical elements" finds antecedent support in the respective underlying independent base claims.

Applicant respectfully submits that the rejection has been obviated in light of the above amendments, and kindly requests favorable reconsideration and withdrawal.

### **Rejection under 35 U.S.C. § 102**

Claims 1, 2 and 12 are rejected under 35 U.S.C. § 102(e) as anticipated by Kimura (6,665,130). Applicant respectfully traverses the rejection.

As amended above, claim 1 recites

An optical head device comprising:

...

one or more aberration correction optical elements which are fixed within a path of said light between said light source and

said objective lens, and correct aberration of said light generated within that path and caused by manufacturing and adjustment errors of the optical components...

(underline per 37 C.F.R. § 1.121)

Similarly, independent claim 12 recites

A method of manufacturing an optical head device comprising the steps of:

...  
selecting, from amongst a plurality of different aberration correction optical elements, based on the results of [a] measured aberration, one or more aberration correction optical elements for correcting the aberration of said light, and then fixing the optical element or elements within said light path of said optical system.

(underline per 37 C.F.R. § 1.121)

These features of independent claims 1 and 12 are neither taught nor suggested by Kimura.

In contrast to the present claims, Kimura discloses that a beam expander (12) includes a negative lens (12b) held by a uniaxial actuator (11) which can move the negative lens in the direction of an optical axis (Col. 22, lines 27-36). Correction of a spherical aberration is effected by moving the negative lens 12b in the direction of the optical axis for an appropriate distance with uniaxial actuator 11 (Col. 22, lines 37-49). According to Kimura, although a spherical aberration can be dynamically corrected, it is necessary to provide a movable means in the optical system, *i.e.*, actuator 11. Because of this, Kimura cannot correct various types of aberrations simply and at a low cost. Kimura teaches a complex and expensive method and apparatus for spherical aberration correction, which the present specification provides a manner of avoiding. Therefore, Kimura does not teach that one or more aberration correction elements, selected from amongst a plurality of different aberration correction optical elements, in accordance with said aberration, are fixed within a path of light between a light source and an objective lens, recited in claim 1. Neither does it teach a step of selecting, from amongst a plurality of different aberration correction optical elements, based on the results of the measured aberration, one or more aberration correction optical elements for correcting the aberration of said light, and then fixing the optical element or elements within the light path of the optical system, recited in claim 12.

It is well-settled that “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

*Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir., 1984). Because Kimura does not teach or suggest all features of independent claims 1 or 12 as illustrated above, Applicant respectfully submits that the rejection has been obviated, and kindly requests favorable reconsideration and withdrawal.

Claim 3 depends from claim 1, and incorporates all features of claim 1 by reference. Claim 3 is separately patentable, but is offered as patentable for at least the same reasons as its underlying independent base claim. Therefore, favorable reconsideration and withdrawal of this rejection is also kindly requested.

### **Rejection under 35 U.S.C. § 103**

Claims 2, 4-5, 9-10 and 13 are rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of alleged Applicant Admitted Prior Art (“AAPA”). Claims 6 and 11 are rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of Minoura (4,139,267). Claim 7 is rejected under 35 U.S.C. §103(a) as obvious over Kimura, in view of Abe (6,084,843). Claim 14 is rejected under 35 U.S.C. §103(a) as obvious over Kimura in view of Sano, *et al.* (6,967,916 ). Claims 15-17 are rejected under 35 U.S.C. §103(a) as obvious over Kimura, in view of Ogawa, *et al.* (5,126,994). Applicant respectfully traverses the rejections.

Each of claims 2-7, 9-11 and 15-17 depend, directly or indirectly from independent claim 1. Each of claims 13-14 depend from independent claim 12. These dependent claims incorporate by reference the features of their respective underlying independent base claims.

The grounds of obviousness rejection are premised upon the application of Kimura to underlying independent base claims 1 and 12, which has been obviated above. None of the foregoing references offer, nor are any alleged to, any teaching or suggestion to ameliorate the deficiencies of Kimura with respect to claims 1 and 12. Therefore, even presuming that the references teach what is attributed to them, and further presuming that there is some apparent reason for one of ordinary skill in the art to the combine the references as proposed in the Office Action, even taken in combination the references do not teach all elements recited in the claims. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Therefore, Applicant respectfully submits that dependent claims 2-7, 9-11 and 13-17 are patentably distinguished over the applied references, taken singly or in any combination. Favorable reconsideration and withdrawal of the rejections is kindly requested.

### Conclusion

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter. Accordingly, the Examiner is respectfully requested to reconsider the application, allow the claims as amended and pass this case to issue.

THIS CORRESPONDENCE IS BEING  
SUBMITTED ELECTRONICALLY  
THROUGH THE UNITED STATES  
PATENT AND TRADEMARK OFFICE  
EFS FILING SYSTEM  
ON FEBRUARY 13, 2008

Respectfully submitted,



---

MAX MOSKOWITZ

Registration No.: 30,576

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700